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09/110,987	07/07/98	GOCHANOUR	G GGG-10003/29

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EXAMINER
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 18

Application Number: 09/110,987
Filing Date: July 07, 1998
Appellant(s): GOCHANOUR, G. GARY

John G. Posa
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed August 29, 2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that

there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 2,3,5,6, and 8 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). It is noted that claims 10, 13-14, and 17 which are drawn to a non-elected invention in paper no. 6 have not been cancelled.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4,607,774	Garr	8-1986
3,229,875	Stoller	1-1966

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 3 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how defining the workpiece (flexible film) defines the claimed invention of a rolled material dispenser assembly.

Claims 1-3, 5-6 and 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Garr in view of Stoller. Garr shows an assembly for dispensing rolled material with all the recited limitations except for the resilient base member that is at least 40 square inches and perforated flexible film.

Garr teaches a dispensing assembly for rolled material that includes a base member between the roll and the edge over which the material is drawn. Although the base member is not at least 40 square inches, it would have been an obvious matter of design choice to provide a base that is at least 40 square inches in order to accommodate large rolls of plastic film, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Additionally, the base member is not resilient. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a resilient material base member, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In regards to claims 3 and 8, Garr does not provide a perforated transparent flexible film. Stoller teaches a dispenser that dispense perforated transparent flexible film (fig. 1, 24). It would have been obvious to one of ordinary skill in the art to provide the apparatus of Garr '774 to dispense perforated flexible film because the perforations assist in the separation mechanism when the film is drawn against an edge.

(11) Response to Argument

Applicant contends that the modifying the base member such that it is at least 40 square inches is not a matter of design choice. However, the Examiner disagrees. As stated the by Appellant, the base member is provide for permitting the placement of the palmer surface of the average adult human hand. The average adult human hand varies from person to person depending on the physical attributes of the individual. Nor has the Appellant has not specifically defined the dimensions of an adult human hand. To modify the base member such that it accommodates varying sizes of a human hand would therefore be a design consideration. Additionally, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Applicant contends that modifying Garr to provide a resilient base member would hamper the usefulness of the device. The resiliency of an object can vary depending on

the material of the object for example from an object constructed of rubber to one of plastic that exhibits some resilient properties. Providing Garr with a plastic base would not hamper the usefulness of the device because the plastic would still be capable of operating as a base for the material as it is drawn from the supply roll. Additionally, providing a resilient base member does not appear to be a critical structural feature of the invention. As cited in claim 5 by the Appellant, the base member may also be constructed of a non-resilient base member.

Applicant contends that there is no motivation to combine Garr with Stoller. Stoller was cited to show that providing a rolled material such as a perforated transparent flexible film is well-known in the art because the perforations assist in the separation mechanism when the film is drawn against an edge. Therefore would have been obvious to one of ordinary skill in the art to provide the apparatus of Garr with a perforated transparent flexible film.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



knt

October 30, 2001



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